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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 030913CON	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number 09/933,709		Filed 08/22/01
	First Named Inventor Charles A. Morris		
	Art Unit 1615	Examiner Gollamudi S. Kishore	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 53,835

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

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Typed or printed name

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Telephone number

9/25/06  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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September 25, 2006

Attorney Docket No. 030913CON  
Pittsburgh, Pennsylvania 15222

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Art Unit: 1615  
In re application of Morris *et al.*  
Method of Producing Vitamin Powders  
Serial No.:09/933,709  
Filed: August 22, 2001  
Examiner Gollamudi Kishore

Mailstop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Arguments and Remarks for Pre-Appeal Brief Conference**

Sir:

In response to the Advisory Action mailed on August 8, 2006 and the final Office Action mailed May 25, 2006 in the above-referenced patent application ("the Application"), Applicants request a Pre-Appeal Brief Conference in accordance with the guidelines which appeared in the July 12, 2005 issue of the *Official Gazette*. Remarks for the conference are presented herein. Filed concurrently herewith are a Pre-Appeal Brief Request for Review (form PTO/SB/33), a Notice of Appeal, and the fee under 37 C.F.R. § 41.20(b)(1). Also filed are a Petition for Extension of Time and the appropriate fee. Any deficiency or overpayment may be charged or credited, respectively, to Deposit Account No. 11-1110.

The issues addressed herein are ripe for appeal in accordance with 37 C.F.R. § 41.31(a)(1) since the claims having been rejected at least twice.

**Arguments**

Applicant filed a response after final, including proposed amendments on July 25, 2006, which resulted in an Advisory Action mailed August 8, 2006. The Advisory Action indicated that Applicants proposed amendments present new issues and the Examiner maintained the rejections under 35 U.S.C. § 112 and U.S.C. § 103(a) for reasons previously of record. Applicants request entry of the proposed amended claims in order to clarify the claims since the proposed amendments will place the claims in better form for appeal. Applicants additionally request withdrawal of the following rejections : 1) the 35 U.S.C. § 112 enablement rejections of claims 18-50 as; 2) the 35 U.S.C. § 112 indefiniteness rejections of claims 19, 27 and 51; and 3) the U.S.C. § 103(a) obviousness rejections of claims 18-52 in view of U.S Patent No. 4,486,435 to Schmidt et al. ("the

‘435 patent’) and U.S Patent No. 4,603,143 to Schmidt et al. (“the ‘143 patent”) since the combined references fail to teach or suggest, either expressly or inherently, each and every element of the claims; that there is no suggestion or motivation to modify or combine the teachings of the references; and that the references teach away from the combination.

### **Enablement**

The Final Office Action asserts that claims 18-50 are not enabled since “generic ‘vitamin’” is thought to encompass more than vitamin E compositions (See, Final Office Action of 5/25/2006, page 2). However, each of the pending claims is not directed towards “generic vitamins.” Claim 1 is directed towards, *inter alia*, at least one fat soluble vitamin; independent claim 26 is directed towards, *inter alia*, at least one fat soluble vitamin; independent claim 29 recites, *inter alia*, liquid mixed tocopherols; and independent claim 22 recites, *inter alia*, at least one vitamin. (See, Response and Amendment under 37 C.F.R. § 1.116, pages 2-7).

Thus, Applicants request clarification of the enablement rejections since various claims out of pending claims 18-52 are directed towards, *inter alia*, species of vitamins that are more specific than “generic vitamins.” For instance, claim 20 recites, *inter alia*, liquid mixed tocopherols; claim 24 recites, *inter alia*, liquid mixed tocopherols; claim 26 recites, *inter alia*, at least one fat soluble vitamin; claim 28 recites, *inter alia*, liquid mixed tocopherols; claim 29 recites, *inter alia*, liquid mixed tocopherols; claim 33 recites, *inter alia*, liquid mixed tocopherols; claim 37 recites, *inter alia*, liquid tocopherols; claim 41 recites, *inter alia*, liquid mixed tocopherols; claim 51 recites, *inter alia*, a tocopherol; and claim 52 recites, *inter alia*, a fat soluble vitamin.

Each of claims 20, 24, 28, 29, 33, 37 and 41 recites the term “tocopherols” which are specifically described in Examples 1-5 of the as-filed specification. (See, Specification as-filed, Examples 1-5). Thus, claims 20, 24, 28, 29, 33, 37 and 41 are enabled. Additionally, on pages 10-11 of the Response and Amendment filed 7/25/06 by the Applicants, the Applicants provided evidence in the form of a Declaration showing that the “fat soluble” vitamins of independent claims 18 and 26 are enabled.

Thus, Applicants respectfully request clarification of the enablement rejections since each of the claims do not recite “generic vitamin,” and neither the Final Office Action nor the Advisory Action has indicated why claims 18, 20, 24, 26, 28, 29, 33, 37 and 41 are not enabled.

### **Indefiniteness**

The Examiner did not enter the proposed amendments to claims 18, 19, 27, 29 and 51 presented in the response to the Final Office Action. The amendments to claims 18 and 29 were deemed by the Examiner to require further consideration as stated in the Advisory Action mailed 08/08/2006 page 3. However, the proposed amendments to claims 18 and 29 do not present new issues as they are directed to clarifying the range of the vitamin concentration (i.e., removing the terms “at least” and “about” from the ranges).

Applicants further proposed to amend claims 19 and 27 in order to address the Indefiniteness rejections of the Final Office Action mailed 05/25/2006 on page 3. These amendments should be entered since they correct the Indefiniteness rejections on page 3 of the Final Office Action mailed 5/25/2006, and further remove issues for appeal.

Thus, Applicants respectfully request that the amendments be entered as they will clarify the claims and remove extraneous issues for appeal.

### **Obviousness Rejections**

Claims 18-52 were rejected as being assertedly obvious over the ‘435 patent in view of the ‘143 patent. However, the cited references do not alone or in combination teach or suggest each and every element of any of claims 18-52. In addition, there is no suggestion or motivation to modify or combine the teachings of the cited references, and, in fact, the ‘143 patent teaches away from using any cornstarch whatsoever.

The Final Office Action states that “Schmidt (‘435) teaches a free flowing non-caking vitamin powder composition comprising about 45 to about 60 percent vitamin, about 2 to about 18 percent of a water insoluble carrier, about 0.2 to about 2 percent hydrophobic silica, and other ingredients...” and that “the insoluble carrier can be starch (See, Final Office Action, page 4, lines 5-13).

As detailed on pages 13-17 in the response to the Final Office Action filed 7/25/2006, a *prima facie* case of obviousness has not been established since the cited references do not teach or suggest each and every element of any of claims 18-52. (See, Response to Final Office Action

filed 7/25/06, pages 13-17). The response to the Final Office Action discusses specific elements recited by various claims, and the Final Office Action does not show where each of these elements are present in the cited references. Thus, without a teaching or suggestion of each and every element of any of claims 18-52, a *prima facie* case of obviousness has not been established.

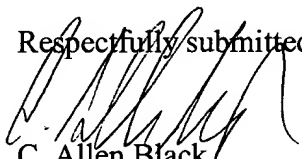
Accordingly, the Applicants request that the Office show where each and every element of claims 18-52 are present in the cited references as required for *prima facie* obviousness. Specifically, Applicants request the Office to show the following elements. With regard to independent claim 18, the Final Office Action does not show where the cited references disclose 65 to 80 weight percent of at least one fat soluble vitamin. The Final Office Action also does not show where the cited references disclose 65 to 80 weight percent of liquid mixed tocopherols as recited in claim 29. The Final Office Action also does not show where the cited references disclose silica with a particle size of between 40 and 50 microns as recited in claims 18, 22, 26 or 29.

Reconsideration and withdrawal of the obviousness rejections of claims 18-52 are requested.

### **CONCLUSION**

Applicants submit that claims 18-52 are in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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